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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,418	11/20/2003	Sara W. Baldwin	0063844-D	9654

7590 08/16/2006

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EXAMINER

AFTERGUT, JEFF H

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/718,418

Applicant(s)

BALDWIN, SARA W.

Examiner

Jeff H. Aftergut

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-20-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of Gold.

The admitted prior art suggested that it was known at the time the invention was made to form a mosaic via a process which included the incorporation of thinner tile portions in a greater detailed region and thicker tile pieces in a less detailed portion of the mosaic. The process of the prior art included the formation of the mosaic on a paper carrier with the subsequent transfer of the mosaic into a thick layer of mortar in order to secure the varied thickness pieces onto the substrate. The admitted prior art suggested that by using this thick layer of mortar with the pieces were able to be positioned wherein the mortar flowed about the varied thicknesses and subsequent to removal of the carrier (the paper carrier) the mosaic was presented in a planar or flush arrangement. The applicant is referred to the description of Figures 3A-3C in the specification. The admitted prior art requires a thick layer of mortar be applied and additionally required the cleaning of the facing of the tiles as the carrier was not removed until subsequent to the setting of the mortar and some mortar will typically contact the surface of the tiles in placement.

Gold taught that it was known at the time the invention was made to form a composite floor design which included the placement of tiles thereon. While the reference did not expressly state that the process was useful for forming a mosaic, the definition of mosaic is "a surface decoration made by inlaying small pieces of variously colored material to form pictures or patterns" and the reference taught that small pieces of tile 16 were arranged to provide a pattern therein on the surface. Gold taught that the designs were formed by assembling thick tile pieces 16 with thin vinyl pieces 18 which could include greater detail therein than the colored tiles. The process involved the application of a substrate 12 having opening therein for receiving the tiles 16 therein on a base floor. The reference taught that one skilled in the art would have applied the thinner vinyl material onto this base 14 with a suitable adhesive material. The reference additionally taught that within the openings 14 of the additional substrate 12 one adhered thicker tiles 16 onto the floor base substrate F with a suitable adhesive. The reference suggested that one skilled in the art would have employed the backing materials on the vinyl substrate in order to allow one to provide a flush and planar arrangement for the design. The applicant is more specifically referred to column 2, lines 64-67 where the reference clearly expressed that the sheet material 18 was able to fill the upstanding portion of the tiles 16 to bring the effective floor surface up the a common level with the top faces of the tiles. The reference suggested that the sheet materials 18 were supplied in strips and that these strips were provided with any desired detailed design one wished. It should be noted additionally that the vinyl pieces are deemed to read on tesserae as the stone, marble, glass terra cotta or like materials

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were used for the same and vinyl is a typical flooring material utilized in a similar manner (and several strips of the material were used in the process). As the backing 12 enabled the thinner portion to be applied with the other tiles and the resulting assembly was level with the other thicker tile portions applied, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of Gold to apply plural thickness tiles to a substrate wherein the finished assembly incorporated tiles of varying thickness for varying detail as the use of the backing in Gold allowed one to present a level surface without having to apply additional mortar for the backing and without having to perform a finishing and/or cleaning step to remove excess mortar from the assembly.

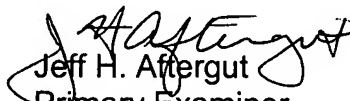
With regard to claims 2-4 and 12-14, one skilled in the art would have been expected to utilize conventionally available tile sizes and those specified are commonplace in the art. Regarding claims 5 and 15, note that tiles for mosaics are typically formed from glass, marble and terra cotta and stone and as such one skilled in the art would have been expected to utilize the conventionally available materials. Regarding claims 6, 7 and 16, note that one skilled in the art would have understood the need for matching the coefficient of thermal expansion of the substrate and the additional substrate to that of the tesserae in order to ensure that the materials stayed laminated to the substrate when exposed to varying temperature conditions. Regarding claims 8-10, the prior art clearly suggested the use of mortar or glue (adhesive) for attachment of the various components together.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeff H. Aftergut  
Primary Examiner  
Art Unit 1733

JHA  
August 14, 2006